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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/591,531	06/09/2000	Lawrence Bernard Kool	RD-27,817	3236

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GENERAL ELECTRIC COMPANY  
GLOBAL RESEARCH  
PATENT DOCKET RM. BLDG. K1-4A59  
SCHENECTADY, NY 12301-0008

EXAMINER

ANYA, IGWE U

ART UNIT PAPER NUMBER

2825

DATE MAILED: 05/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/591,531

Applicant(s)

KOOL ET AL.

Examiner

Igwe U. Anya

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22, 25, 27-37 and 39-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-22, 25, 27-37 and 39-41 is/are allowed.
- 6) ☒ Claim(s) 42-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Terminal Disclaimer*

1. The terminal disclaimer filed on March 17, 2004 disclaiming the terminal portion of any patent granted on this application, which would extend beyond the expiration date of application 09/682,862 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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4. Claims 42 to 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanai et al. (JP Patent. 3566166386) in view of Matsukawa (US Patent Number 5962145).

5. Kanai et al. teach a method of selectively removing lead dioxide coating on a titanium substrate by immersing in a solution of hydrosilicofluoric acid or its salt in the presence of acetic acid and hydrogen peroxide as a stabilizer for 10 to 20 hours at a bath temperature of 60 to 80 degrees C. Inherently all acids have a pH of less than 7 in pure water.

6. Kanai et al. lack the concentration of the hydrosilicofluoric acid being between 0.05 – 3.5M, the concentration of the acetic acid being between 0.1 – 20M with a pH of less than 3.5 in pure water, and immersing the substrate in a bath for about 10 minutes to about 72 hours.

7. However, Matsukawa teaches additional acid and concentration (column 3 lines 37 – 65), also the additional acid being a mineral acid having a pH of less than about 3.5 in pure water, and the claimed treatment time (column 6 table 1).

8. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Matsukawa into the Kanai et al. reference to etch a coating. Discovering an optimum value for a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

9. Claims 1 – 22, 25, 27 – 37 and 39 – 41 are allowable in view of filled terminal disclaimer.

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10. Prior art considered, but not used in the rejection include Kiya et al. (US Patent 6274027).

**Remarks**

11. The examiner Applicant's arguments filed March 3, 2004 have been fully considered but they are not persuasive. Matsukawa discloses removal of a coating on a substrate by a fluorometal acid when the concentration of the fluorometal acid exceeds 10,000 ppm. Kanai et al. teach removal of a coating on a substrate using same acid. The determination that a reference is from a non-analogous art is twofold. First, we decide if the reference is within the field of the inventor's endeavor. If it is not, we proceed to determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved. Furthermore, Kanai et al. teach applicant's claimed invention except for the concentration of the acid. As such Kanai et al. can be used as a stand alone to reject the claims under USC 103 in view of Aller, 105 USPQ 233. *(Where the general conditions of a claim are disclosed in prior art, discovering the optimum or working ranges involves only routine skill in the art).*

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**Contact Information**

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igwe U. Anya whose telephone number is (571) 272-1887. The examiner can normally be reached on M - F 8:30am - 5:00pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew S. Smith can be reached on (571) 272-1907. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Igwe U. Anya  
Examiner  
Art Unit 2825

IA

May 11, 2004



MATTHEW SMITH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2800